

REMARKS

New claims 26 and 27 have been added. The application has thirteen pending claims, including independent claims 20 and 22 and dependent claims 3, 4, 6, 14, 15, 21 and 23-27. All rejections are respectfully traversed. Favorable reconsideration of the claims is respectfully requested.

35 USC 102(e)

Claims 3, 4 and 20-23 are rejected under 35 USC 102 (e) as being anticipated by US 6,499,332 to Markwald.

In order for a claim to be anticipated under 35 U.S.C. §102, each and every element, as set forth in the claim, must be found, either expressly or inherently, in a single prior art reference (*Verdegaal Bros. v Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)), the identical invention must be shown in as complete detail as is contained in the claim (*Richardson v Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)), and the elements must be arranged as required by the claim (*In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990)).

Claims 20 and 22 each recite a sliding mechanism configured to mount the seat tray for forward and rearward sliding movement in a single plane with respect to the base in a low friction manner.

Markwald fails to disclose such a mechanism. Markwald discloses a guide (17), which may qualify as a sliding mechanism, but Markwald does not suggest that the guide is configured to mount the seat tray for forward and rearward sliding movement in a single plane, as recited in the claims. As a consequence, Markwald fails to disclose each and every element arranged as required by the claims or the identical invention in as complete detail as is contained in the claims. In the absence of such disclosure, the claims cannot be anticipated by Markwald. Consequently, the rejection of the claims is improper and should be withdrawn.

Claims 20 and 22 further recite a pivot point for a seat back positioned at the anatomical hip of the user of the seating system and a pivot point for a leg support positioned at the anatomical knee of the user.

Markwald fails to disclose such pivot points. Markwald appears to disclose seat back and knee pivot points (9) and (11) but Markwald does not suggest that the pivot points are positioned at the anatomical hip and knee of the user, as recited in the claims. As a consequence, Markwald fails to disclose the identical invention in as complete detail as is contained in the claims. To this end, the claims cannot be anticipated by Markwald. Consequently, the rejection of the claims is improper and should be withdrawn.

If an independent claim is allowable, then any claim depending therefrom is allowable. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Claims 3, 4, 6, 14, 15, 21 and 23-25 depend from claims 20 and 22 and should be allowable for at least the same reasons as claims 20 and 22, as set forth above.

In addition, claims 3 and 23 recite a sliding mechanism that limits the sliding movement of a seat tray to a substantially horizontal movement.

Markwald fails to disclose a seat tray limited to substantially horizontal movement. Markwald discloses a seat surface (7), which may qualify as a seat tray, but Markwald does not suggest that the seat surface is limited to substantially horizontal movement, as recited in the claims. As a consequence, Markwald fails to disclose every element arranged as required by the claims or the identical invention in as complete detail as is contained in the claims. In the absence of such disclosure, the claims cannot be anticipated by Markwald. Consequently, the rejection of the claims is improper and should be withdrawn.

35 USC 103(a)

Claim 6, 14, 15, 24 and 25 are rejected under 35 USC 103(a) as being unpatentable over Markwald in view of US 327,775 to Dodge.

To establish a prima facie case of obviousness, the claimed invention must be considered as a whole and the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182 187 n.5 (Fed. Cir. 1986). Moreover, the references, when combined, must teach or suggest all the claim limitations and the teaching or suggestion to make the claimed combination must be found in the references, and not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). A statement that modifications of the references to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

Claims 6, 14, 15, 24 and 25 depend from claims 20 and 22 and should be allowable over Markwald for at least the same reasons as claims 20 and 22, as set forth above. Dodge fails to cure the deficiencies in Markwald.

In addition, claims 6, 14 and 24 recite a seat back that is connected to a back support member, wherein downward movement of the back support member in a substantially vertical direction with respect to a base causes the seat back to pivot at a seat tray, thereby reclining the seat back, and thereby causing the seat tray to slide forward with respect to the base.

Markwald fails to disclose a seat back that moves downward to cause the seat back to pivot at a seat tray and thereby recline, which in turn causes the seat tray to slide forward with respect to a base, as admitted by the Examiner. The Examiner interprets a shaft (H) disclosed by Douglas to be a seat back support member. However, Douglas fails to disclose a seat tray and there is no teaching or suggestion that downward movement of the shaft can cause a seat tray to slide forward with respect to a base. To this end, the references, when combined, do not teach or suggest

all the claim limitations. Consequently, the rejection of the claims as being obvious is improper and should be withdrawn.

Intended Use

The Examiner argues that the recitation of a sliding mechanism mounting a seat tray for forward and rearward movement in a single plane is a recitation of intended use, and that such a recitation must result in a structural difference between the claimed invention and the recited references. The Examiner concludes that if the prior art is capable of performing the function, the prior art meets the functional limitation.

First, the recitation of a sliding mechanism mounting a seat tray for forward and rearward movement in a single plane is not a recitation of intended use. Intended use is a legal term which generally refers to language found in the preamble. The language referred to by the Examiner is not in the preamble.

Intended use language is generally not accorded any patentable weight where it merely recites the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the structural limitations are able to stand alone. In the instant application, the language referred to by the Examiner as intended use language is in the body of the claim, not in the preamble.

Intended use recitations and other types of functional language cannot be entirely disregarded. As admitted by the Examiner, if the prior art structure is capable of performing the intended use, then it meets the claim. None of the cited references have a sliding mechanism capable of mounting a seat tray for forward and rearward movement in a single plane or substantially horizontally, as recited in the claims. As can be clearly seen in the drawings of Markwald, the backrest (8) is pivotally connected to the frame (4). The seat surface (7) moves via the guide (17). As this is done, the distance between the backrest pivot and the footrest pivot (11) increases. As this distance increases, the seat surface (7) move upward and forward, as depicted in the drawings. It is not capable of moving in a single plane or moving horizontally or

substantially horizontally, as recited in the claims. This movement results in a structural difference between the claimed invention and the recited references.

Functional Language

The Examiner opposes the use of functional language, citing *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). *In re Schreiber* does not disparage the use of functional language. It only shifts the burden to Applicants to prove that the subject matter in the cited references does not possess the characteristics relied upon by the Examiner. Applicants have met this burden in the remarks above in connection with every point of rejection by the Examiner.

The Examiner also cites *Hewlett-Packard Co. v. Bausch and Lomb Inc.*, 15 USPQ2d 1525 (Fed. Cir. 1990). In this case the Appellate Court relied on functional language (i.e., spring biased together to cause) in determining whether a claim was obvious. The Appellate Court decided that the functional language distinguished the claimed invention from the prior art.

In re Danly, 120 USPQ 528 (CCPA 1959) did not prohibit the use of functional language. In fact, the Appellate Court found the claims directed toward an apparatus for heating tie rods (i.e., functional language) should have been allowed.

Lastly, in *In re Swinhart and Sfiligo*, 69 USPQ 226 (CCPA 1971), the Appellate held that there is nothing intrinsically wrong with the use of functional language in patent claims. The Appellate Court further recognized a practical necessity for use of functional language, citing *In re Halleck*, 164 USPQ 647 (1970).

New Claims

New claims 26 and 27 recite a tilt-in-space block having a guide slot configured to receive a pivot post and a guide pin. None of the cited patents disclose or teach the invention in claims 26 and 27. Consequently, these claims should be allowable as presented.

Conclusion

In view of the above remarks, it is believed that the application is in condition for allowance. Accordingly, favorable reconsideration and a prompt Notice of Allowance are respectfully requested.

Request for Telephone Interview

As a final matter, if the Examiner does not find the application in condition for allowance, prior to issuance of another Office Action, Applicants' undersigned attorney requests the courtesy of a telephone interview at the Examiner's earliest convenience to discuss the application. Applicants' undersigned attorney may be contacted at (419) 255-5900.

Respectfully submitted,

Thedford I. Hitaffer
Reg. No. 38,490

MacMillan, Sobanski & Todd, LLC
One Maritime Plaza, Fifth Floor
720 Water Street
Toledo, Ohio 43604
(419) 255-5900